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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,346	03/12/2004	Kozo Nogi	Q80405	5598
65565 7590 08/10/2007 SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213				
			EXAMINER ZEMEL, IRINA SOPJIA	
			ART UNIT 1711	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/798,346	<b>Applicant(s)</b> NOGI ET AL.	
	<b>Examiner</b> Irina S. Zemel	<b>Art Unit</b> 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 7-26 is/are allowed.
- 6) ☒ Claim(s) 2,4,5,6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102/103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 2 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 5,672,633 to Brehm et al., (hereinafter "Brehm").

The rejection stands as per reasons of record.

### ***Claim Rejections - 35 USC § 103***

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brehm in combination with US patent 4,295,281 to Potter (hereinafter "Potter").

The rejection stands as per reasons of record.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brehm.

The rejection stands as per reason of record as the examiner is of the opinion that the recitation of a specific design of the apparatus does not contribute the manipulative step. In addition, it is the examiners position that the recited downward inclination is no more than an obvious design choice of the recited apparatus to facilitate transport of the polymer particles along the apparatus.

***Response to Arguments***

Applicant's arguments filed 4-26-2007 and 6-4-2007 with regard to claims 2, 5 and 6 have been fully considered but they are not persuasive. The applicants argue that claim 2 is allowable for the same reasons as claim 1. While the examiner agrees with the applicants arguments regarding amended claim 1, claim 2 does not recite limitations similar to those recited in the amended claim 1 that limit the stirring by controlled force vibration generated by a mechanical vibration. Claim 2 still recites stirring by "vibration" not limited to any specific vibration which still reads on any vibration generated by any physical force the process of operating a fluidized bed which inherently utilized forced air flow and by using it inherently vibrates (shakes) the powder.

The applicants further argue that the examiner has not shown where Brehm discloses removing at least a part of the fine particles of the water-absorbing resin powder and/or the residual cross linking agent with the forced air flow, at the same time the mixture is being cooled. The applicants are correct that the Examiner did not recite any specific portions of the reference expressly teaching removal of particles. This is because the rejection was based on inherent phenomenon that takes place (inherently) during the process disclosed by the reference and not on expressed disclosure of the reference. The examiner expressly pointed out why it is believed that the particle removal limitation of claim 2 is inherently met by the process disclosed by Brehm. The burden was shifted to the applicants to provide factual evidence to the contrary, however the applicants have chosen to argue this limitation rather than provide factual

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evidence. The argument that the examiner did not meet her burden is unconvincing since, as discussed above, it misinterprets underlying inherency rejection.

Similarly, with respect to claim 5 (as depending on claim 2), the examiner provided reasons why it is believed that the process disclosed by Brehm inherently meets the claimed limitation of particle agglomeration. In response, the applicants merely state that the reference does not disclose the claimed limitation without pointing out why the limitation is not inherently met and without providing any reasons. Such arguments are not persuasive at all.

Regarding claim 4, the applicants argue that Potter teaches away from reduced pressure fluidized bed apparatuses by stating that in the preferred embodiments the apparatus is operated at normal pressure. This argument is not convincing since Potter expressly discloses that fluidized bed can be operated under vacuum (reduced pressure), and it is clearly and well established by the courts that the disclosure of a reference is not limited to the preferred embodiments only.

Insofar as the arguments regarding claim 6, the arguments are addressed in the rejection set forth above.

***Allowable Subject Matter***

Claims 1, and 7-26 are allowed.

The reasons for allowance are set forth in the previous office action, and, in addition, the limitations of the amended claim 1 are not obvious from the cited art of record as pointed out in the applicants response of 4-26-2007.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Irina S. Zemel  
Primary Examiner  
Art Unit 1711



ISZ